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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,310	12/16/2004	Ernst Horvath	2002P09312WOUS	6665

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

MATTIS, JASON E

ART UNIT	PAPER NUMBER
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2416

MAIL DATE	DELIVERY MODE
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04/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,310	Applicant(s) HORVATH ET AL.	
	Examiner JASON E. MATTIS	Art Unit 2416	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37 and 51 is/are rejected.
- 7) ☐ Claim(s) 38-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment filed 12/18/08. Claims 1-36 have been canceled. New claims 37-51 have been added. Claims 37-51 are currently pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 51, line 2 of this claim contains the term "the second terminal capability set message (TSCB)". It appears that this term is attempting to reference the term "a second terminal capability set message (TCSA)" from line 16 of claim 50, which claim 51 depends on; however, the term from claim 50 is labeled "TCSA" while the term from claim 51 is labeled "TCSB". It is recommended that claim 51 be amended such that "the second terminal capability set message" is labeled as "TCSA" consistent with the label used in claim 50.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over ITU-T Recommendation H.323 (as cited by the Applicant's IDS filed 12/16/04) hereafter referred to as H.323 in view of Lee et al. (U.S. Pat. 7031279 B2) .

With respect to claim 37, H.323 discloses a method for controlling a connection in a packet-oriented communication network comprising a first network zone with a first signaling control device and a first terminal and a second network zone with a second signaling control device and a second terminal **(See section 7.3.1 and Figures 9 and 34 of H.323 for reference to a connection control method in a packet network including a first network zone having a gatekeeper 1, which is a first signaling control device, and an endpoint 1, which is a first terminal, and a second network zone having a gatekeeper 2, which is a second signaling control device, and an endpoint 2, which is a second terminal)**. H.323 also discloses a first data communication channel transmitting communication the first to the second terminal and a second data communication channel transmitting user data from the second to the first terminal wherein the channels form a peer-to-peer communication relationship between the first and second terminals **(See section 7.3.2 and Figure 12 of H.323 for**

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reference to a first H.245 channel transmitting data from endpoint 1 to endpoint two and a second H.245 channel transmitting data from endpoint 2 to endpoint 1 forming a peer-to-peer communication relationship between the endpoints).

H.323 further discloses the first signaling control device sending a message to the first terminal prompting the first terminal to close the data communication channel **(See section 8.5.3 and Figure 34 of H.323 for reference to gatekeeper 1 sending a DRQ 3 message to endpoint 1 prompting endpoint 1 to close the data communication channel)**. H.323 also discloses the first terminal sending a message transparently via the first and second signaling control devices to the second terminal prompting the second terminal to close the data communication channel **(See section 7.3.2, section 8.5.3, and Figures 12 and 34 of H.323 for reference to endpoint 1 sending an EndSessionCommand 1 to endpoint 2 prompting endpoint 2 to close the channel and for reference to all data sent between endpoints 1 and 2 being sent transparently via gatekeepers 1 and 2 according to one embodiment, as shown in Figure 12)**. H.323 further discloses the second terminal sending a confirmation message transparently via the first and second control devices to the first terminal **(See section 8.5.3 and Figure 34 of H.323 for reference to endpoint 2 sending an EndSessionCommand 2, which is a confirmation message to the first endpoint 1 via the gatekeepers)**. H.323 also discloses the first terminal sending a message as a closure confirmation to the first signaling control device **(See section 8.5.3 and Figure 34 of H.323 for reference to endpoint 1 sending a DCF 4 message to gatekeeper 1 confirming the closure)**. Although H.323 does disclose transmitting messages

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between devices performing the claimed functions, H.323 does not specifically disclose the messages including a TCS0 message, a CLC message, and a CLCAck message. H.323 also does not disclose the first signaling control device transmitting a second TCS message with a non-empty capability set to the first terminal prompting the first terminal to open a new data channel as a result of receiving the information request response.

With respect to claim 37, Lee et al., in the field of communications, discloses transmitting a TCS0 message, a CLC message, and a CLCAck message between devices as a part of a channel closure procedure **(See column 11 line 60 to column 12 line 35 and Figure 7 of Lee et al. for reference to transmitting a TCS=0 message to initiate a channel closure, and transmitting CLC and CLCAck messages as a part of the channel closure procedure)**. Lee et al. also discloses transmitting a second TCS message with a non-empty capability set to prompting a terminal to open a new data channel as a result of receiving a information request response **(See column 11 line 60 to column 12 line 35 and Figure 7 of Lee et al. for reference to transmitting a second TCS message to an endpoint prompting the endpoint to open a new data channel)**. Using the messages disclosed by Lee et al. has the advantage of allowing normal messaging to be able to close one connection and open another connection as a part of a handoff procedure between terminals.

It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Lee et al., to combine using the messages disclosed by Lee et al. with the system and method of H.323, with the motivation being

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to allow normal messaging to be able to close one connection and open another connection as a part of a handoff procedure between terminals.

Allowable Subject Matter

6. Claims 38-50 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 51 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 37-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON E. MATTIS whose telephone number is (571)272-3154. The examiner can normally be reached on M-F 8AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason E Mattis
Examiner
Art Unit 2416

JEM

/Jason E Mattis/
Examiner, Art Unit 2416